

Appln. No. 10/058,602
Amendment dated July 19, 2004
Reply to Office Action mailed May 17, 2004

REMARKS

Reconsideration is respectfully requested.

Entry of the above amendments is courteously requested in order to place all claims in this application in allowable condition and/or to place the non-allowed claims in better condition for consideration on appeal.

Claims 1 through 16 and 45 through 25 remain in this application. Claims 17 through 23 have been cancelled. No claims have been withdrawn. Claims 26 and 27 have been added.

The Examiner's rejections will be considered in the order of their occurrence in the Office Action.

Paragraph 3 of the Office Action

Claims 1 through 16 and 21 through 25 have been objected to for the informalities noted in the Office Action.

Claim 21 has been cancelled, and claim 1 has been amended in a manner believed to further clarify any informalities in the language.

Withdrawal of the objection to claims 1 through 16 and 24 through 25 is therefore respectfully requested.

Paragraphs 4 through 6 of the Office Action

Claims 2 through 4, 6 through 12, 16 and 21 through 25 have been rejected under 35 U.S.C. §102(b) as being anticipated by Stein, U.S. Patent 1,921,489, or in the alternative, under U.S.C. 103(a) as obvious over Stein.

Claims 21 through 23 have been cancelled.

Claim 2 requires, in part, "at least one sheet support *removably mountable* on a lower portion of the carriage and *positionable* along the carriage for supporting a lower edge of a sheet good positioned on the

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carriage" (emphasis added). This feature of the claimed invention, as pointed out at pages 9 and 10 of the previous response,

. . . permits the adjustable positioning of the sheet support on the carriage for supporting a lower edge of a sheet good, especially when the face of the sheet good is rested on or against the carriage. As the actual location of the cutting operation on the sheet goods will vary, the ability to easily move and reposition the sheet support on the carriage is significant, so that the sheet support may be moved away from the location of the cut if necessary.

It is alleged in the Office Action at page 3, as a part of the anticipation rejection under 35 USC 102(b), that (emphasis added):

Stein discloses the same invention as claimed including, e.g., . . . at least one sheet support (9) removably mounted on a lower portion (see Figure 4) of the carriage and positionable along the carriage for supporting a lower edge of the workpiece (the supports 9 are attached to the carriage by c-clamp like structures that inherently allow for adjustable along the carriage.

However, while the Stein patent appears to show some sort of opening and closing clamp structure comprised of elements 7 and 8 that is employed to rest against the top or upper surface of the sheet of glass, the same structure is not shown for element 9 of Stein, which is called a "stop piece" and appears to have a different function than the function of elements 7 and 8 in the Stein apparatus. Even if one were to assume, for the purposes of argument, that the element 9 did have the same structure as elements 7 and 8 of Stein, nothing in Stein discloses, or even suggests, that the positions of elements 7 and 8 are movable.

The Office Action at page 3 goes on to state that:

In the alternative, even if it is argued that Stein lacks the sheet support that is positionable along the carriage, it would have been obvious to one having ordinary skill in the art at the time the invention was made to allow the sheet supports of Stein to be adjustable together or independently in order to accommodate different sized workpieces, because it has been held that the provision of adjustability, where needed, involves only routine skill in the art.

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However, this line of reasoning seems to merely be an adoption of the benefits of the applicant's claimed structure as pointed out in applicant's previous response (as reproduced above), rather than any motivation in the prior art to alter the Stein structure. As Stein does not appear to disclose any adjustment of the stop pieces 9, or the clamping structures formed by elements 7 and 8, it is clear that such a motivation does not come from the Stein patent.

Further, as to the allegation that "it has been held that the provision of adjustability, where needed, involves only routine skill in the art", it is submitted that the Office Action contains no showing originating in the prior art that the provision of adjustability is "needed", except for the aforementioned statement in the Office Action that merely echoes the benefits of the claimed structure set forth in the applicant's prior response. As for the allegation that the courts have held that "the provision of adjustability, when needed, involves only routine skill in the art", it appears that this statement is based upon Section 2144.04(V)(D) of the Manual of Patent Examining Procedure (MPEP), 8th ed., rev. 2, which states in full (emphasis added):

In re Stevens, 212 F.2d 197, 101 USPQ 284 (CCPA 1954) (Claims were directed to a handle for a fishing rod wherein the handle has a longitudinally adjustable finger hook, and the hand grip of the handle connects with the body portion by means of a universal joint. The court held that adjustability, where needed, is not a patentable advance, and because there was an art-recognized need for adjustment in a fishing rod, the substitution of a universal joint for the single pivot of the prior art would have been obvious.).

While this portion of the MPEP does include a statement similar to the statement in the Office Action, it is noted that the summary of the Stevens case set forth in the MPEP is not as broad as suggested in the Office Action, as the statement in the MPEP includes the qualification that "*because there was an art-recognized need for adjustment in a fishing rod*" (emphasis added), that the provision of adjustability was not patentable under the facts

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of that case. In contrast, in the present case, the Patent Office has not established that there was an "art-recognized need" for such adjustability. To the contrary, the cited Stein patent appears to show non-adjustability in the allegedly anticipating elements of the Stein apparatus, and thus does not lead one of ordinary skill in the art to believe that there is a need for adjustability, as the Stein apparatus appears to function well without such adjustability.

It is therefore submitted that the Stein patent does not anticipate or render obvious the requirements of claim 2 of the patent application, and allowance of claim 2, as well as the claims that depend from claim 2, is respectfully requested.

Withdrawal of the §102(b) rejection of claims 2 through 4, 6 through 12, 16 and 24 through 25 is therefore respectfully requested.

Paragraph 7 of the Office Action

Claim 1 has been indicated as appearing to be allowable over the prior art of record, and it is submitted with the language changes requested above in response to the Section 112 objections, that claim 1 is in condition for allowance.

Paragraph 8 of the Office Action

Paragraph 8 of the Office Action states that claims 5 and 13 through 15 would be allowable if written into independent form with the limitations of the base claim and any intervening claims.

The above amendment incorporates the limitations of claims 2 and 5 into the recitation of added claim 26, and therefore claim 26 is believed to be in condition for allowance.

The above amendment incorporates the limitations of claims 2, 12 and 13 into the recitation of added claim 27, and therefore claim 26 is believed

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to be in condition for allowance. Claims 28 and 29, by virtue of their dependency from added claim 27, are also submitted to be in condition for allowance.

CONCLUSION

In light of the foregoing amendments and remarks, early reconsideration and allowance of this application are most courteously solicited.

Respectfully submitted,

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